



FEB 19 2002

In re

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:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 35, 39, and 42 of the morning session and question 39 of the afternoon session of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 66. On July 12, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 10.2

and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: “No points will be awarded for incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement

true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner’s arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional points. No credit has been awarded for morning question 35, morning question 39, or morning question 42. No credit has been awarded for afternoon question 39. Petitioner’s arguments for these questions are addressed individually below.

Morning question 35 reads as follows:

34 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions. Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 U.S.C. § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor’s oath or declaration and without the required filing fee. The Office issued a “Notice to File Missing Parts – Filing Date Granted” on April 2, 2001. The Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001. Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during

the trip. Upon his return to the United States on July 26, 2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied. A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief. An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

35. In addition to the facts set forth in connection with the previous question, Joseph's application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Joseph submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) By requesting nonpublication of the application, Joseph "opted out" of the statutory framework for patent term extension and, therefore, no patent term extension is available.
- (B) Submission of the nonpublication request does not affect any patent term extension that might be available to Joseph.
- (C) Joseph may rescind his nonpublication request at any time.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

The model answer is selection (E).

Nonpublication of the application does not affect the patent term extension provisions of the Patent Term Guarantee Act of 1999. Thus, statement (B) is true. The patent term extension provisions of 37 C.F.R. §§ 1.702 et seq. are separate and independent of the eighteen-month publication provisions. There is no support for statement (A). An applicant may rescind a nonpublication request at any time. See “37 CFR Parts 1 and 5 -- Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule,” Federal Register Vol. 65, No. 183 (9/20/2000) at 57024, middle column. Thus, statement (C) is also true. Accordingly, the best answer is (E).

Petitioner argues that choice (B) is the most correct answer because answer (C) is not the most correct answer. Petitioner has argued that because the inventor did not comply with the requirements of 37 C.F.R. § 1.213(4)(b)(1-3), the applicant may not rescind his nonpublication request at any time. Petitioner’s arguments have been fully considered but they are not persuasive. 35 U.S.C. 122(b)(2)(B)(iii) specifically provides that “An applicant may rescind a request made under clause (i) at any time. Correspondingly 37 C.F.R. 1.213(b) specifically provides that “The applicant may rescind a nonpublication request at any time.” While it is true that the request under 37 C.F.R. 1.213(b) must: (1) Identify the application to which it is directed; (2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and (3) Be signed in compliance with § 1.33(b), all of these requirements can be met at any time by Joseph, the applicant. Accordingly, both (B) and (C) are true as provided in the model answers, rendering (E) the most correct answer. No error in grading has been shown. Petitioner’s request for credit on morning question 35 is denied.

Morning question 39 reads as follows:

39. Which of the following is/are required to be included in a request for reexamination submitted by a person other than the patent owner on January 12, 2001?

- (A) A statement pointing out each substantial question of patentability based on the arguments stated by the examiner in the first Office action.
- (B) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112.
- (C) A copy of the entire patent including the front face, drawings, and specification/claims, in double column format on single-sided sheets, for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.
- (D) A certification that a copy of the request has been served in its entirety on “the patent owner at the address as provided for in § 1.33(c),” without indicating the name and

address of the party served.

(E) None of the above.

The model answer is selection (C).

37 C.F.R. § 1.510(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (September 8, 2000). As stated in 65 FR at 54649, middle column, “Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only.” Thus (C) is correct. (A) is incorrect because 37 C.F.R. § 1.510(b)(1) requires that each substantial new question of patentability be based on prior patents and publications. (B) is incorrect because the statement in (B) is required by 37 C.F.R. § 1.293(b), not by 37 C.F.R. § 1.510(b). (D) is incorrect because under 37 C.F.R. § 1.510(b)(5), the name and address of the party served must be indicated if the request is by a person other than the patent owner.

Petitioner argues that “answer (C) is not the most correct since it does not restrict the disclaimer, certification of correction, or reexamination certificate issued in the patent to only one side of a sheet of paper.” It is true that 37 C.F.R. 1.510(b)(4) requires that “All copies must have each page plainly written on only one side of a sheet of paper.” It is also true that answer (C) omits any indication that the copies of any disclaimer, certificate of correction, or reexamination certificate must have each page plainly written on only one side of a sheet of paper. However, this further requirement provided in 37 C.F.R. 1.510(b)(4) does not make answer (C) incorrect. All of the requirements specified in answer (C) are specified in 37 C.F.R. 1.510(b)(4). Accordingly, choice (C) is the correct answer. No error in grading has been shown. Petitioner’s request for credit on morning question 39 is denied.

Morning question 42 reads as follows:

42. Registered practitioner Rick files a utility patent application under 37 C.F.R. § 1.53(b) in the USPTO having one claim on May 6, 1998. Following a proper final rejection dated June 28, 2000, of claim 1 Rick files a request for continued examination with the appropriate fee on September 12, 2000, and submits an amendment to claim 1 with the request. On October 7, 2000, Rick learns about a publication (the “Columbus reference”) which he knows to be material to patentability of claim 1, but which was not considered by the examiner during prosecution of the application. Rick prepares an information disclosure statement that complies with the provisions of 37 C.F.R. § 1.98, listing the Columbus reference. The finality of the action dated June 28, 2000, is withdrawn in an Office action, dated November 20, 2000, which is after the filing of the request for continued examination. Which of the following actions, if taken by Rick, will properly

result in the Columbus reference being considered by the Office during the pendency of the application?

(A) Filing the information disclosure statement on November 15, 2000, without any further statement and without the fee set forth in § 1.17(p).

(B) Filing the information disclosure statement on December 11, 2000, without any further statement and without the fee set forth in § 1.17(p).

(C) Filing the information disclosure statement on December 13, 2000, without any further statement and without the fee set forth in § 1.17(p).

(D) Choices (A) or (B) above.

(E) None of the above.

The model answer is selection (A).

37 C.F.R. § 1.97(b)(4) and (c), effective date November 7, 2000; see, "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54630 (September 8, 2000); and 37 C.F.R. § 1.114, effective date August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092 (Aug. 16, 2000). (A) is correct since November 15, 2000, is "before the mailing of a first Office action after the filing of a request for continued examination under § 1.114" (37 C.F.R. § 1.97(b)(4)). As stated in 65 FR 54630, column 2, "As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination. Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 C.F.R. § 1.97(c). (E) is incorrect since (A) is correct. (D) is incorrect because (B) is incorrect.

Petitioner argues that exam answer (A) is incorrect because it did not include the statement from either 37 C.F.R. § 1.97(e)(a) or 37 C.F.R. § 1.97(e)(2) required by 37 C.F.R. § 1.97(c)(1). Petitioner's argument is not persuasive because 37 C.F.R. 1.97(c)(1) does not apply. In answer (A), the information disclosure statement was filed on November 15, 2000. The Office action was not mailed until November 20, 2000. Accordingly, 37 C.F.R. 1.97(b)(4) applies because the IDS was filed before the mailing of a first Office action after the filing of a request for continued examination under 37 C.F.R. 1.114. 37 C.F.R. 1.97(c) does not apply because the IDS was filed within the period specified paragraph (b) of 37 C.F.R. 1.97. Accordingly, (A) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on morning question 42 is denied.

Afternoon question 39 reads as follows:

39. Which of the following requests by the registered practitioner of record for an interview with an examiner concerning an application will be granted in accordance with proper USPTO rules and procedure?

(A) A request for an interview in a substitute application prior to the first Office action, for the examiner and attorney of record to meet in the practitioner's office without the authority of the Commissioner.

(B) A request for an interview in a continued prosecution application prior to the first Office action, to be held in the examiner's office.

(C) A request for an interview in a non-continuing and non-substitute application, prior to the first Office action to be held in the examiner's office.

(D) None of the above.

(E) All of the above.

The model answer is selection (B).

37 C.F.R. § 1.133 (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54640-54641 (September 8, 2000). As stated in 65 FR at 54641, left column, "Comment 65: One comment urged that interviews be allowed in a CPA prior to a first action. Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications that conform to practice set forth in the MPEP." Thus, (B) is correct. (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 C.F.R. § 1.133(a)(1). (C) is incorrect because an interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application. 37 C.F.R. § 1.133(a)(2). (D) is incorrect because (B) is correct. (E) is incorrect because (A) and (C) are incorrect.

Petitioner has argued that because answer (B) does not indicate that it is to be conducted within Office hours as required by 37 C.F.R. § 1.133(a)(1), it is an incorrect answer. The argument is not persuasive. Afternoon question 39 asks which request "will be granted in accordance with proper USPTO rules and procedure." 37 C.F.R. 1.133(a)(2) provides that "An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application." Because a CPA is a continuing application, the request in (B) for an interview in a continued prosecution application prior to the first Office action, to be held in the examiner's office, should be granted in accordance with

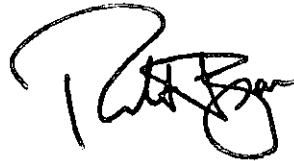
proper USPTO rules and procedure. There is nothing in the facts to indicate that the practitioner is unavailable during Office hours. Accordingly, the examiner would coordinate with the practitioner to arrange a time within Office hours. It is true that if the Commissioner authorized the interview to take place outside Office hours, it could take place outside Office hours. Irrespective of whether the interview is granted during Office hours or granted at another time authorized by the Commissioner, it would be granted in accordance with proper USPTO rules and procedure. Accordingly, (B) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on afternoon question 42 is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy